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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/732,785	12/11/2003	Hiroyuki Matsukawa	42534-4717	6919

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SNELL & WILMER LLP
1920 MAIN STREET
SUITE 1200
IRVINE, CA 92614-7230

EXAMINER	
FRANCIS, FAYE	
ART UNIT	**PAPER NUMBER**
3712	

DATE MAILED: 06/01/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/732,785	MATSUKAWA, HIROYUKI	
	Examiner	Art Unit	
	Faye Francis	3712	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *10 December 2003*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-3 and 5-14* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-3 and 5-14* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *12/10/03*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

2. Claims 6 and 10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 6 recites the limitation "said game board covering" in line 2. There is insufficient antecedent basis for this limitation in the claim.

With respect to claim 10: the phrase "the first magnet member is mounted in the lower shaft body" is confusing since it requires that the first magnet be mounted in the lower shaft body when in fact the first magnet has already been mounted in the cavity of the main body.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 5-6 are rejected under 35 U.S.C. 102(b) as being anticipated by Span.

Span discloses in Figs1-5, a game board including a base board 11 having an upper surface [Fig 2], a game board 14 detachably mounted on an upper surface of the base board [where it is considered that anything can be detached from something else

by disassembly or breaking the two pieces apart] and a receiving means 16 as required in claim 5 and a transparent [col 3 line 10] board cover 14 as required in claim 6.

Since the reference includes all of the structured elements of the claims it is presumed to be inherently capable of all of the claimed functions.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6. Claims 1-3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Andrews et al'283 hereinafter Andrews in view of Nonaka et al hereinafter Nonaka.

Andrews

Andrews discloses a toy top game containing most of the elements of the claims including with reference to claim 1, a game board [housing depicted in figure 2], means for interacting a toy top and a game board including a first magnet means [30] and a second magnet means [figure 2,electric magnet]. A base board [16], a game board [12], a receiving means [hollow area encompassed by elements 10, 16 and 12 in figure 2] and a game board and a base board being detachable mounted, as required by claim 2, are all shown in figure 2 and described in [col 1, lines 56-63].

Andrews fails to explicitly teach a driving means as required by claim 1 and a portion of a game board being transparent as required by claim 3, however Nonaka discloses a toy top game, which teaches a top driving means [figures 5-8]. Therefore it

would have been obvious to one having ordinary skill in the art, at the time of the claimed invention to incorporate the top shape and driving means of Nonaka in the game of Andrews for the purpose of providing a drive means capable of mechanically driving a toy top in a simple manner, especially since Andrews clearly states that the toy top of his invention can take on a variety of shapes and designs [col 4, lines 63-64]. Additionally a game board being transparent is considered to be an obvious choice of design in that the applicant discloses no advantage or critical need for such construction

7. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Osawa (US Publication 2002/0102907).

Osawa discloses a toy top containing most of the elements of the claims including a toy body having a shaft [figure 1, element 4] arranged at a lowermost portion, a mount support means [figure 3, element 5], detachable overlapping blade members [figure 2, elements 2-3].

Osawa lacks a magnet means being arranged on a rotational axis. However, Andrews discloses a magnetic spin top game which teaches providing a magnet means arranged on a rotational axis [figure 2, element 30]. Therefore it would have been obvious, in view of Andrews, to incorporate a magnet arranged on a rotational axis of a toy top for the purpose of being able to effect a toy top movement through the use of a magnetic fields thereby providing amusement to the user.

Double Patenting

8. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11

F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

9. Claims 1-3 and 5-8 are rejected under the judicially created doctrine of non-statutory double patenting over claims 1-3 of U.S. Patent No. 6,739,939, hereinafter US'939. Although the conflicting claims are not identical, they are directed to the same inventive concept and are not patentably distinct from each other because the subject matter of the application claims is fully disclosed and covered by the patented claims. The patented claims are inclusive for they are drafted using the comprising-type" format and cover the subject matter of the application claim(s). Since applicant has obtained the right to exclude others from making and using the subject matter set forth in the claims of this application by virtue of the copending application claims, the issuance of this application into a patent without a terminal disclaimer as provided for under 37 CFR § 1 .321 (b) would amount to an unjustified extension of this right.

10. Claims 9-14 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-3 of U.S. Patent No. 6,739,939, hereinafter US'939. Although the conflicting claims are not identical, they are not patentably distinct from each other because they set forth subject matters, which are obvious over each other and only differ in breadth of terminology used. For

example, the limitation "a first and second magnets" in claims 9-14 of the application is an obvious variation in meaning of the limitation "means for interacting the toy top and the game board" in copending Application No. 10/136724 claims 1-3 because the first and second magnets and the means for interacting the toy top and the game board are disclosed as being the same feature.

Conclusion

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Faye Francis whose telephone number is 703-306-5941. The examiner can normally be reached on M-F 6:30-3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Derris Banks can be reached on 703-308-1745. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

DERRIS H. BANKS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3700

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